

## **REMARKS**

This paper is filed in response to the Office Action dated March 1, 2004. As this paper is filed on July 1, 2004, and is accompanied by a request and corresponding fee for a one-month extension, this paper is timely filed.

### **I. Status of Amendments**

Claims 1-85 were pending prior to this amendment. By this amendment, applicant cancels claims 1-85 without prejudice to refile, and adds new claims 86-100. Thus, claims 86-100 are now pending.

Because applicant previously paid fees for 4 independent and 85 total claims, applicant's amendments require no further fees beyond the one month extension of time attached herewith.

### **II. Response to Office Action**

#### **A. General Comments**

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.<sup>1</sup> For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the term "invention" may be used to refer to subject matter which is nonobvious; and the term "invention" may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term "invention" in various statements does not mean that the scope of the claims is limited by such statements.

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<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

It should also be understood that, unless a term is expressly defined in the application using the sentence “As used herein, the term ‘ \_\_\_\_\_ ’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. *In re Wright*, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. *Vas-Cath Inc. v. Mahurkar*, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

**B. The March 1 Office Action**

In the March 1 Office Action, the drawings were objected to for line weight and lettering in Figs. 4-5 and a lack of explanatory text in Fig. 6. Figs. 4-6 have been amended. The applicants request that the objection to the drawings be withdrawn.

Also in the March 1 Office Action the specification, more specifically, the abstract and the title were objected to. The abstract and the title have been amended and the applicants request that the objections to the specification be withdrawn.

Claim 11 was objected to as allegedly missing the word “spaces.” As claim 11 has been canceled, the objection is moot.

Further, claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by Colin et al. (U.S. Patent No. 6,346,043) and claims 2-38 as being unpatentable over Colin in view of combinations of Mirando (U.S. Patent No. 5,411,271), Baerlocher et al. (U.S. Patent No. 6,669,559), and Bennett (U.S. Patent No. 6,572,471). As claims 1-38 have been cancelled, without prejudice to refile, these rejections are moot. However, given the reliance placed on Colin, Mirando, Baerlocher, and Bennett, the applicant has the following comments.

Claim 86 recites, “A gaming method comprising receiving a wager from a player; displaying an image representing a game; determining if an event has occurred; displaying an array including a plurality of spaces if the event has occurred, each of the plurality of spaces having an indicium associated therewith that matches with at least one other indicium associated with another of the plurality of spaces; revealing the indicia associated with the plurality of space for a period of time when a requirement occurs during the game, the requirement comprising one of matching certain indicia, revealing a specified indicium, and reaching an achievement level; concealing the indicia associated with the plurality of space after revealing the indicia for the period of time; receiving a first selection of one of the plurality of spaces after revealing the indicia for the period of time, revealing the indicium associated with the one of the plurality of spaces; receiving a second selection of another of the plurality of spaces; revealing the indicium associated with the another of the plurality of space; determining if the indicia associated with the one and the another of the plurality of spaces match; and providing an award if the indicia associated with the one and the another of the plurality of spaces match.”

In particular, claim 86 recites revealing the indicia of the plurality of spaces for a period of time when a requirement occurs during the game, the requirement comprising one of matching certain indicia, revealing a specified indicium, and reaching an achievement level, concealing the indicia of the plurality of spaces after revealing the indicia of the plurality of spaces for the period of time, and receiving a first selection of one of the plurality of spaces after revealing the indicia of the plurality of spaces. Applicants respectfully submit that Colin et al., Mirando, Baerlocher et al. and Bennett, whether taken individually or in combination, do not disclose teach or suggest these limitations.

In regard to Colin et al., Colin et al. expressly states that the indicia associated with the boxes are revealed as they are selected by the player. Col. 3:41-46 (“For example, if the player selects the player-selectable area or box at row 1, column 4 of the play area by

touching the screen within this area, the image and award previously assigned to this area will be displayed within the box as shown in FIG. 4 and described in step 3 of FIG. 1.”). Once a group is completed, then all the indicia are shown to the player. Col. 3:66 – Col 4:1 (“As shown in FIG. 7 and described in step 7 of FIG. 1, the images and awards assigned to any unselected boxes are revealed. “). Colin et al. also expressly states that FIG. 2 is not disclosed to the player, but is for illustrative purposes only. Col. 3:2-4 (“Although an example of such an assignment is illustrated in FIG. 2, the assignment of the images and awards is not disclosed to the player.”). Thus, Colin et al. does not disclose, teach or suggest the limitations particularly recited above; in fact, Colin et al. appears to teach away from the claimed subject matter in this regard.

In regard to Mirando, while Mirando discloses a matching game wherein some or all of the game pieces are disclosed before the player selects one of the game pieces (Col.5:9-14 (“In a first mode all curtains raise and lower at once; in a second mode only three windows are uncovered at one time; and, in a third mode, the machine randomly decides to uncover two windows at a time, or three windows at a time, or all windows at once.”)), the time the curtains are raised is not tied to performance of the player in some prior event. In this regard, while Mirando discusses a timer, the timer referred to controls game time, not the amount of time the curtains are raised. Col. 5:14-17 (“Perhaps the most important feature of the game 10 is the "Timer" which allows the operator to change the game time from 20 to 60 seconds in 5 second intervals.”). Thus, Mirando does not provide the disclosure, teaching or suggestion missing from Colin et al.

As for the references to Baerlocher et al. and Bennett, neither of these patents provides the missing disclosure, teachings and suggestions in regard to the particularly cited limitations above. Consequently, these patents, whether taken individually or in combination with Colin et al. and/or Mirando, do not disclose, teach or suggest each and every limitation of the claimed subject matter.

Therefore, claim 86 is allowable. Given that claims 87-95 depend from claim 86 and that claim 86 is distinguishable over Colin et al., Mirando, Baerlocher et al., and Bennett, so too are claims 87-95.

Independent claim 96 recites, "A gaming system comprising: a display device; a currency acceptor; a card reader; a player input device; and at least one computer unit operably coupled to the display device, the currency acceptor, the card reader, the player input device and a memory, the at least one computer unit receiving a wager via the wager input device from a player; the at least one computer unit causing the display unit to display an image representing a game; the at least one computer unit determining if an event has occurred; the at least one computer unit displaying an array including a plurality of spaces if the event has occurred, each of the plurality of spaces having an indicium associated therewith that matches with at least one other indicium associated with another of the plurality of spaces; the at least one computer unit revealing the indicia for a period of time when a requirement exists, the requirement comprising one of matching certain indicia, revealing a specified indicium, and reaching an achievement level during the game; the at least one computer unit concealing the indicia after revealing the indicia for a period of time; the at least one computer unit, subsequent to concealing the indicia, receiving a first selection of one of the plurality of spaces; the at least one computer unit revealing the indicium associated with the one of the plurality of spaces; the at least one computer unit receiving a second selection of another one of the plurality of spaces; the at least one computer unit revealing the indicium associated with the another of the plurality of space; the at least one computer unit determining if the indicia associated with the one and the another of the plurality of spaces match; and the at least one computer unit providing an award if the indicia associated with the one and the another of the plurality of spaces match."

In particular, claim 96 recites revealing the indicia for a period of time when a requirement occurs during the game, the requirement comprising one of matching certain indicia, revealing a specified indicium, and reaching an achievement level, concealing the indicia after revealing the indicia for the period of time, and receiving a first selection of one of the plurality of spaces after concealing the indicia. As discussed above, these limitations are not disclosed, taught or suggested by Colin or Mirando, nor are they disclosed, taught or suggested by additional references Baerlocher et al. and Bennett. Since none of the cited references teach each and every limitation of the independent claim 96, the claim is allowable. Therefore, claims 97-100 that depend from claim 96 are also allowable.

In summary, in view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested.

**C. The Supplemental Information Disclosure Statement**

Enclosed herewith is a Supplemental Information Disclosure Statement in regard to the above-mentioned application.

By this Supplemental Information Disclosure Statement, applicant cites U.S. Patent Application No. 10/029,384 (“the ‘384 application”), U.S. Published Application No. 2003/0114220, which is the published version of the ‘384 application, and U.S. Patent No. 6,746,328, (“the ‘328 patent”) which corresponds to the ‘U.S. Patent Application 10/151,556 application. Further, applicant cites those documents not previously cited to or by the U.S. Patent and Trademark Office in the above-mentioned application that were cited to or by the U.S. Patent and Trademark Office during the prosecution of the ‘384 application and the ‘328 patent.

The undersigned also notes the following. The named inventor of the ‘384 application is a named co-inventor of the above-mentioned application. Moreover, the assignee of the ‘384 application at the time of filing, Anchor Gaming, was the assignee of the above-mentioned application at the time of filing. Further, the ‘384 application and the above-mentioned application were both transferred from Anchor Gaming to the present assignee, IGT. However, neither the undersigned nor his firm prepared the above-mentioned application or the ‘384 application, and the undersigned did not become aware of a relationship between the disclosure of the ‘384 application and the disclosure of the above-mentioned application until recently, when he reviewed Office Actions issued in regard to the ‘384 application and this application.

The undersigned further notes the following. The the ‘328 patent is presently assigned to IGT. However, the undersigned did not become aware of a relationship between the disclosure of the the ‘328 patent and the disclosure of the above-mentioned application until recently, when he reviewed the Office Action issued in regard to this application.

If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below. Further, if

there are any additional fees or refunds required, the Commissioner is directed to charge or debit Deposit Account No. 13-2855.

Dated: July 1, 2004

Respectfully submitted,

By 

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Attachments